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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,160	06/13/2001	Shigehisa Tonomura	1341.1095	3652
21171	7590	09/09/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ARSHAD, UMAR	
			ART UNIT	PAPER NUMBER
			2174	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/879,160	<b>Applicant(s)</b> TONOMURA, SHIGEHISA	
	<b>Examiner</b> Umar Arshad	<b>Art Unit</b> 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

This communication is responsive to the amendment filed 5/12/2004.

Claims 1 – 19 are pending in this application. Claims 1, 6 – 12, and 19 are independent claims. In the amendment, claims 1 – 4 and 6 – 12 were amended and claims 13 – 19 were added. This action is made Final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 3 – 13, 15, 17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Yokota, U.S. Patent No. 6,604,049.

As per claim 1, Yokota teaches an information providing method comprising the steps of:

accepting photographed data including photographing position information from a user (see Yokota, column 3, lines 31 – 35);

acquiring a content corresponding to the photographing position information from a position-distinction contents database based on the photographing position information in the accepted photographed data, wherein said position-distinction contents database stores photographing position information and the content in a correlated manner (see Yokota, column 3, lines 40 – 45 and column 9, lines 16 – 28); and

inserting and editing the acquired content into a portion of the photographed data corresponding to the photographing position information (see Yokota, column 10, lines 8 – 14),

wherein the content includes data symbolizing an area which corresponds to the photographing position information and in which the photographed data is originally obtained (see Yokota, column 4, lines 2 – 6).

As per claim 3, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota further teaches the information providing method

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according to claim 1, wherein the accepting step further includes the steps of,

accepting information for specifying the user along with the photographed data including the photographing position information (see Yokota, column 9 lines 45 – 52); and

transmitting the inserted and edited photographed data to the user based on the accepted information for specifying the user (see Yokota, column 6, lines 18 – 22).

As per claim 4, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota further teaches the information providing method according to claim 1, wherein the photographed data are data photographed in a certain bigger area, and the photographing position information is information about a smaller area in the bigger area where the photographing is executed or information showing a photographing spot (see Yokota, figure 8 and column 11, lines 46 – 63).

As per claim 5, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota further teaches the information providing method according to claim 1, wherein the photographed data are frames of original dynamic images (see Yokota, column 7, lines 52 – 55; the examiner interprets images captured by a digital camera as frames of original dynamic images).

As per claim 6, Yokota teaches an Information receiving method comprising the steps of:

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transmitting photographed data including photographing position information to a server; and

receiving the photographed data, into which contents corresponding to the photographing position information are inserted and edited by the server, from the server based on the transmitted photographing position information (see Yokota, column 3, lines 31 – 45).

As per claims 7, 9, 11 and 12, they are of similar scope to claim 1 and are rejected under the same rationale as claim 1 (see rejection above).

As per claims 8 and 10, they are of similar scope to claim 6 and are rejected under the same rationale as claim 6 (see rejection above).

As per claim 13, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota further teaches the information providing method according to claim 1, further comprising:

transmitting the inserted and edited photographed data to the user based on information specifying the user, to increase a value of the photographed data as a commemorative photograph (see Yokota, column 6, lines 18 – 22; the examiner interprets sending additional data regarding a location of interest to the user as increasing the value of the photographed data as a commemorative photograph because it allows a user to gain more information regarding the photographed data),

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wherein the photographed data accepted from the user includes the information specifying the user (see Yokota, column 9 lines 45 – 52).

As per claims 15 and 17, they are of similar scope to claim 13 and are rejected under the same rationale as claim 13 (see rejection above).

As per claim 19, Yokota teaches an image processing system, comprising:

a database including photographic position information and an image content correlated with the photographic position information, the image content including image data of an area corresponding to the photographic position information (see Yokota, column 3, lines 40 – 45 and column 9, lines 16 – 28);

a user client device which transmits photograph data including photographic position information of where the photograph data was obtained (see Yokota, column 3, lines 31 – 35);

a computer which acquires the image content correlated with the photographic position information from the database when the user client transmits the photograph data, and which inserts the acquired image content into the photograph data (see Yokota, column 10, lines 8 – 14).

Claims 2, 14, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokota, U.S. Patent No. 6,604,049 in view of Yoon et al., U.S. Patent No. 6,173,407.

As per claim 2, which is dependent on claim 1, Yokota teaches the method of claim 1 (see rejection above). Yokota does not teach the information providing method according to claim 1 further comprising the step of calculating an appropriate fee for providing the contents. Yoon et al. ("Yoon") teaches an information providing method comprising the step of calculating an appropriate fee for providing content (see Yoon, column 7, lines 9 - 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Yoon with the method of Yokota in order to generate revenue for the content provider.

As per claims 14, 16 and 18, they are of similar scope to claim 2 and are rejected under the same rationale as claim 2 (see rejection above).

### ***Response to Arguments***



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Applicant's arguments with respect to claims 1 - 19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umar Arshad whose telephone number is (703) 305-0329. The examiner can normally be reached on Monday - Friday, 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on (703) 308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UA

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